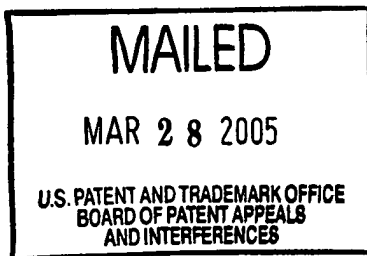


UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte ROMAN S. FERBER
and
STEPHEN CHUNG

Application No. 09/833,401

ORDER RETURNING TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on March 4, 2005. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith electronically returned to the examiner. The matters requiring attention prior to docketing are identified below.

On April 15, 2004, appellants filed a Notice of Appeal "from the decision of the Examiner dated March 30, 2003." The "Status of Claims" section located on page 2 of the Appeal Brief filed June 17, 2004 states that "[c]laims 1-25 are pending in this application. Claims 1-25 have been rejected and are the

subject of this appeal." While the examiner agrees with the above statement (see Examiner's Answer mailed August 25, 2004, page 2), the "Grounds of Rejection" section appearing on page 3 of the Answer states:

Claims 1-7 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stern in view of Lin and further in view of Haraga. . . .

Claims [sic] 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stern in view of Lin and Haraga as applied to claim 1 and further in view of Barrada. . . .

Claims 1 and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin in view of Haraga. . . .

Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin in view of Haraga, and further in view of Sandrin. . . .

Claims 14-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sandrin in view of Cook.

It should be noted that the Final Rejection mailed January 13, 2004, the Appeal Brief filed June 17, 2004, and the Examiner's Answer mailed August 25, 2004 do not appear to discuss the rejection of claim 10. Appropriate correction is required.

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In addition, on page 3 of the Examiner's Answer mailed August 25, 2004, the examiner improperly refers to two previous Office actions (one mailed September 10, 2003 and the other mailed January 13, 2004). Section 1208(A) of the Manual of Patent Examining Procedure (MPEP) (8th Ed., Rev. 2, May 2004) states:

Examiners may incorporate in the answer their statement of the grounds of rejection merely by reference to the final rejection (or a single other action on which it is based, MPEP § 706.07). Only those statements of grounds of rejection appearing in a single prior action may be incorporated by reference. An examiner's answer should not refer, either directly or indirectly, to more than one prior Office action.

Furthermore, MPEP § 706.07 states:

In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated. They must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal unless a single previous Office action contains a complete statement supporting the rejection.

Compliance with MPEP § 1208 is required.

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Accordingly, it is

ORDERED that the application is returned to the
examiner:

1. for a determination regarding the status of
claim 10;
2. for compliance with MPEP § 1208 regarding the
grounds of rejection appearing in the Examiner's Answer mailed
August 25, 2004;
3. for a written communication to appellants regarding
the action taken; and
4. for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By: 

DALE M. SHAW
Program and Resource Administrator
(571) 272-4579

DMS:psb

cc: Kevin J. Heintz
Brooks & Kushman, P.C.
22nd Floor
1000 Town Center
Southfield, MI 48075-1351